

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion is respectfully requested.

Claims 1-39 are pending in the application. Claims 31-38 are amended by the present amendment. Support for amended Claims 31-38 can be found in the original specification, claims and drawings.¹ Thus, no new matter is presented.

In the outstanding Official Action, Claims 1-39 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite; and Claims 31-38 were objected to under 35 U.S.C. § 101, as directed to non-statutory subject matter.

The outstanding Official Action objected to Claims 31-38 as directed to a non-statutory subject matter because these claims recite “a recording medium which is not limited to tangible embodiments.”² The Official Action further states that the recording medium “could be non-tangible”.³

In response, independent Claims 31 and 33 are amended to further recite “a computer-readable storage medium for storing program instructions for execution on a computer system, which when executed by the computer system causes the system to perform...”

MPEP 2106.01 states:

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since the use of technology permits the function of the descriptive material to be realized.

Amended Claim 31 now recites a “computer readable storage medium” having functional descriptive material in the form of program instructions. Further, a “computer readable

¹ Specification at page 42, lines 14-27.

² Outstanding Official Action at page 3, first paragraph.

³ Id.

storage medium” is clearly tangible because it is a medium, on which descriptive material is stored then read and executed by a computer.

Accordingly, Applicant respectfully requests that the rejection of Claims 31-39 under 35 U.S.C. § 101 be withdrawn.

Claims 1-39 were rejected under 35 U.S.C. § 112, second paragraph, as containing a relative term. Specifically, the Official Action cited the term “the LYEE development method” and states that this method is not defined by “the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonable apprised of the scope of the invention”⁴ However, as discussed in detail in the previous response and evidenced by the three published patent applications submitted therewith, the LYEE development method was well known and established at the time of the invention.⁵ Thus, at the time of the invention, one of ordinary skill in the art would clearly have been apprised of the scope of the invention based on a review of the above-noted published patent applications.

Moreover, lines 18-21 at page 1 of the specification specifically note that the “LYEE (governmental methodologY for softwarE ProvidencE) program development method has been registered as a means for revolutionizing the conventional software creation methods ...” (emphasis added). Accordingly, there is nothing “relative” about the claimed “LYEE development method” and no need to ascertain any “requisite degree” of anything. The PTO clearly is in error in attempting to first suggest that there is some kind of “degree” associated with the claimed “LYEE development method,” like there is for the term “about,” for example.

Furthermore, the rejection appears to be founded on the improper supposition that “the standard or procedure for the LYEE development method could [not even must or will]

⁴ *Id.* at page 2, item 4.

⁵ U.S. Pat. Nos. 6,138,268, 6,532,586 and 6,792,594, all to Negoro.

change over time” and an apparent attempt to correlate these PTO imagined possible changes to real variations constituting some kind of “degree,” apparently as to the possible future varieties of methods that might be called LYEE development method. However, what might or might not happen to the “LYEE development method” existing as a conventional method when this application was filed and known as such at this time to those skilled in the art has nothing to do with the meaning of the term as included in the present claims. As was explained in *Schering Corp. v. Amgen Inc.*, 222 F.3d 1347, 1352-54, 55 USPQ2d 1650, 1653-55, (Fed. Cir. 2000), when a claim term understood to have [one] meaning when the application is filed later acquires a [different] definition, the literal scope of the term is limited to what it was understood to mean at the time of filing.

The outstanding Official Action also erroneously relies on the mere chance that “the standard or procedure for ‘LYEE development method’ could change over time” to conclude that one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.”⁶ However, Applicant submits that since the LYEE development method was known at the time of the invention, one of ordinary skill in the art would clearly be appraised of the scope of the invention at the time the application was filed, which, as noted above, is the critical time. Further in this regard, the prior art teachings set forth above cannot be ignored because “... the definiteness of the language employed must be analyzed - not in a vacuum, ***but always in light of the teachings of the prior art*** and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.” *In re Moore*, 439 F.2d 1232, 169 USPQ 236, (CCPA 1971). As discussed above, one of ordinary skill in the art at the time of the invention would clearly be able to ascertain the LYEE development method and how the LYEE development method worked at the time of the invention based on at least the prior art cited in the previous response.

⁶ Outstanding Official Action, at page 2, item 4.

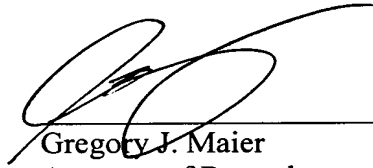
Therefore, one of ordinary skill in the art would clearly be apprised of the scope of the invention at the time the application was filed.

Accordingly, Applicant respectfully submits that Claims 1-39 are definite, and that the rejection of these claims under 35 U.S.C. § 112, second paragraph, be withdrawn.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by claims 1-39 is definite. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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